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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,827

03/04/2004

Patrick Arachequesne

P24953

3641

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7590

09/14/2006

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EXAMINER

CLEMENT, MICHELLE RENEE

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/791,827	ARACHEQUESNE, PATRICK	
	Examiner	Art Unit	
	Michelle (Shelley) Clement	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection as necessitated by applicant's amendments.

Specification

2. The amendment filed 6/21/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the length of the straight section of the first end being less than the vertical thickness of the end section was not described in the application filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the combination comprising "a plate".

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the end section comprising a thickness wherein a length of the straight section of the first end is less than the vertical thickness of the end section must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

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sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 27-46 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The length of the straight section of the first end being less than the vertical thickness of the end section was not described in the specification at the time the application was

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filed for all thicknesses and all lengths. There are combinations of lengths and thicknesses that are disclosed by applicant's original figures which do not meet the limitation and therefore amounts to new matter, since applicant has not specifically pointed out or defined which thickness and which length is referred to.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 27-46 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's recitation "the end section comprising a thickness measured in a vertical direction when the longitudinal direction is horizontal" is indefinite in that the end section comprises several thicknesses defined by such and it is not clear to the examiner which thickness applicant is referring to in that neither the claims nor the specification particularly defines which of the several thicknesses applicant is attempting to claim. Furthermore, neither the specification nor the claims define which length applicant intends to be encompassed by the claim language.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 27-32, 35, 36, 38, 40-43, 45, 46, and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (US Patent # 5,671,561). Johnson et al. discloses a combination of a firearm and mount arrangement that can be used to mount a holographic sight on an upper side of at least one barrel of a firearm, the at least one barrel extending in a longitudinal direction and having a muzzle end, and end section of the firearm behind defined between the muzzle end and the holographic sight, the end section comprising a thickness measured in a vertical direction when the longitudinal direction is horizontal, the combination further comprising; a plate comprising a first end and a second end and the first end comprising a straight section and the second end being mounted to the holographic sight wherein a length of the straight section of the first end is less than the vertical thickness of the end section. The first end of the plate is positioned above a lowermost point of the end section. The second end of the plate comprises a straight section. The plate comprises a curved section arranged between the first and second ends. The second end is mounted to a bottom side of the holographic sight. The first end is mounted to the mounting arrangement via a dovetail groove and a dovetail strip. The mounting arrangement comprises a dovetail groove configured to receive a dovetail strip. The dovetail groove extends in the longitudinal direction. The plate comprises an arc-shaped section. The second end is fixed to a bottom side of the holographic sight. The second end of the plate comprises a straight section. The second end is fixed to the holographic sight via at least one screw. The holographic sight is removably connected to the firearm and is a red dot sight device. The holographic sight arranged on an upper side of at least one barrel of the firearm.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27, 33-37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bechtel (US Patent # 4,367,606). Bechtel discloses the combination of a firearm and mount arrangement that can be used to mount a sighting device (including a holographic sight) on an upper side of at least one barrel of the firearm, the at least one barrel extending in a longitudinal direction and having a muzzle end, and end section of the firearm being defined between the muzzle end and the sighting device, the end section comprising a thickness measured in a vertical direction when the longitudinal direction is horizontal, the combination further comprising a plate comprising a first end and a second end and the first end comprising a straight section and the second end being mounted on the sighting device. The first end comprises a dovetail groove and the firearm comprises a dovetail strip configured to receive the dovetail groove. The first end is connected to a side of the firearm via a mounting arrangement and the second end is positioned over the upper side of the at least one barrel. The dovetail groove comprises an abutment arranged on the muzzle end side of the dovetail groove and an opposite open end through which the dovetail strip can be inserted. Bechtel discloses the claimed invention except for explicitly stating that the length of the straight section of the first end is less than the vertical thickness of an end section of the firearm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the specific sizes in order to minimize the weight of the mount.

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Bechtel discloses the claimed invention except for the dovetail strip located on the mount and the dovetail groove located on the firearm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to reverse the location of the parts, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. It is noted that the [a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

12. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bechtel as applied to claim 27 above, and further in view of McMillon (US Patent # 4,509,282). Although Bechtel does not expressly disclose the firearm being an over and under shotgun, McMillon does. McMillon discloses an over and under shotgun having a sight mounting. Bechtel and

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McMillon are analogous art because they are from the same field of endeavor: firearms and sights. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the shotgun as taught by McMillon with the mount as taught by Bechtel. The suggestion/motivation for doing so would have been to obtain a sight that was easily removed.

13. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph (US Patent # 3,555,687) in view of DePaoli (US Patent # 5,373,644). Joseph discloses the combination of a firearm and sight arranged on an upper side of at least one barrel of the firearm, the combination comprising the at least one barrel extending in a longitudinal direction and having a muzzle end, an arc-shaped support comprising a first end and a second end and the first end being mounted to only one side of the firearm (the top side) and the second end being mounted to a bottom side of the sight. Although Joseph does not expressly disclose the sight being a holographic sight, DePaoli does. Joseph and DePaoli are analogous art because they are from the same field of endeavor: firearms and sights. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the holographic sight as taught by DePaoli with the firearm and mount as taught by Joseph. The suggestion/motivation for doing so would have been to obtain a firearm and sight where the cross hairs could be seen at times when visibility is low as suggested by DePaoli (column 1, lines 15-20).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Paige (US Patent # 6,327,806), Houde-Walter (US Patent # 7,069,685), Strahan (US Patent # 4,418,487), and Tai et al. (US Patent # 6,490,060).

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15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MICHELLE CLEMENT
PRIMARY EXAMINER